



19 JUN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

#2

J. Ernest Kenney  
Bacon & Thomas, PLLC  
625 Slaters Lane - Fourth Floor  
Alexandria, VA 22314

In re Application of	:	
KOLBECK	:	DECISION ON RENEWED
Serial No.: 09/926,517	:	
PCT No.: PCT/EP00/04781	:	PETITION UNDER
Int. Filing Date: 25 May 2000	:	
Priority Date: 27 May 1999	:	37 CFR 1.47(b)
Atty Docket No.: KOL P3001/JEK	:	
For: METHOD AND DEVICE FOR SAVING	:	
AND RETRIEVING PIN CODES	:	

This decision is in response to the applicant's "Renewed Petition Under 37 C.F.R. § 1.47(b)" filed in the United States Patent and Trademark Office (USPTO) on 03 April 2003 to accept the application without the signature of inventor Alexander KOLBECK.

### **BACKGROUND**

On 20 September 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b) to accept the present application without the signature of inventor Alexander KOLBECK. Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended with a proper petition and payment of the appropriate extension of time fee.

On 03 April 2003, applicant filed the present renewed petition under 37 CFR 1.47(b) accompanied by a petition for a four-month extension of time and a check in the amount of 1450.00 as payment of the four-month extension of time. Applicant is advised that a four-month extension of time would result in a due date of 20 March 2003. As such, \$520.00 will be deducted from Deposit Account No.: 02-200 and the extension of time petition will be considered as a petition for a **five-month** extension of time. With the additional payment, applicant's petition is considered timely filed.

### **DISCUSSION**

As detailed in the decision mailed 20 September 2002, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(I); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a

**Declaration of Jochen Höhfeld**  
**U.S. Patent Application No. 09/926,517**

1. My name is Jochen Höhfeld, I am a German citizen and qualified as a German and European patent attorney engaged in the practice of intellectual property law in the firm Patentanwälte Klunker, Schmitt-Nilson, Hirsch located in Munich, Germany, of which firm I am a partner.
2. I represent the assignee of record of U.S. Patent Application Serial No. 09/926,517 in Germany, namely Giesecke and Devrient GmbH of Munich, Germany (which I may refer to as the "Company" below), and I am familiar with this application, including the fact that a Mr. Alexander Kolbeck of Weilheim, Germany was named as inventor in the application but thus far has refused to sign the declaration for the application or a formal assignment of same.
3. I have reviewed the Declarations of Messrs. Harms and Branzka and Ms. Teichmann as well as documents confirming Mr. Kolbeck's former employment by the company, all of the documents reflecting Mr. Kolbeck's refusal to execute the declaration and assignment for the U.S. application and attempts that were made by these individuals to obtain such signature.
4. It is my opinion based on my knowledge of employee and employer rights respecting inventions made during employment that the Company is legally the owner of all rights to the invention disclosed and claimed in U.S. Application No. 09/926,517 and that a German court, if presented with the issue of ownership of the invention, would rule in favor of the Company. My opinion is based on the facts stated in Mr. Harms' declaration and my personal review of the documents appended as Exhibits 4, 5, 6, 7 and 8 to the Harms declaration. From

**Declaration of J. Höhfeld**

these documents, I have concluded that the inventor and the Company fulfilled conditions and mutual obligations necessary to establish ownership in the invention by the Company under the German Act On Employee Inventions, and thus I fully agree with Mr. Harms' assessment of the Company's position respecting such ownership.

5. My opinion is specifically based on the provisions of the German Act On Employee Inventions and the information I have reviewed regarding Mr. Kolbeck's employment when the invention (so-called "service invention") was made. Specifically, in accordance with Sect. 5(1) of the Act:

Any employee making a service invention shall be under a duty to report the invention to his employer immediately in a special written notice indicating that said writing constitutes the report of an invention. [...] The employer shall inform his employee without delay and in writing of the date the report was received.

After receiving such report, the employer may claim ownership of the invention within four months, per Sect. 6 of the Act:

(1) An employer may claim a service invention by means of an unlimited or a limited claim.

(2) Such claim shall be made in a written statement addressed to the employee. This shall be made as soon as possible, and no later than 4 months from the receipt of the proper report...

If the employer fails to comply with this four months term, the right to the invention will in general remain with the employee. The effect of claiming an employee's invention, i.e. a service invention, by the employer is defined in Sect. 7 of the Act:

## Declaration of J. Höhfeld

(1) On the receipt of a written declaration of an unlimited claim, all rights in service and pension should pass to the employer.

(2) [...]

(3) Dispositions of a service invention made by an employee before his employer has declared a claim, shall have no effect on his employer, insofar as the employer's rights are concerned.

I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

April 2, 2003  
Date

Jochen Höhfeld  
Jochen Höhfeld

statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1), (3), and (6).

As to item (2), applicant has presently provided a declaration from Mr. Siegfried Harris avowing to the fact that inventor Kolbeck was provided with a complete set of the application papers on 11 November 2002 and to date no response has been received.

Regarding item (4), applicant has presently provided a declaration executed on behalf of the corporate entity and the non-signing inventor which details the titles of the executing parties and shows that they are employed in positions for which they can execute legal documents on behalf of the corporation.

As to item (5), applicant has provided a declaration from Jochen Hohfeld, an attorney familiar with German law in which he provides his opinion that a competent German court would find that the corporate entity, Giesecke and Devrient GmbH, has a legal right to the present invention. Mr. Hohfeld's declaration contains relevant excerpts from the German "Act on Employee Inventions."

A review of the present renewed petition and accompanying exhibits finds that applicant has now satisfied all six items detailed above and it is proper to grant applicant's renewed petition at this time. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

### **CONCLUSION**

Applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application will be given an international application filing date of 25 May 2000 and a date of **03 April 2003** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision, namely, the mailing of a NOTIFICATION OF ACCEPTANCE UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903).



Richard Cole  
Legal Examiner  
Office of PCT Legal Administration



Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration  
Tel: (703) 305-0130  
Fax: (703) 308-6459



19 JUN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

Mr. Alexander Kolbeck  
Merowingerstrabe 12  
D-82362 Weilheim  
GERMANY

In re Application of  
KOLBECK  
Serial No.: 09/926,517  
PCT No.: PCT/EP00/04781  
Int. Filing Date: 25 May 2000  
Priority Date: 27 May 1999  
Atty Docket No.: KOL P3001/JEK  
For: METHOD AND DEVICE FOR SAVING  
AND RETRIEVING PIN CODES

Dear Mr. Kolbeck:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Richard Cole  
Legal Examiner  
Office of PCT Legal Administration

Derek A. Putonen  
Attorney Advisor  
Office of PCT Legal Administration

J. Ernest Kenney  
Bacon & Thomas, PLLC  
625 Slaters Lane - Fourth Floor  
Alexandria, VA 22314  
United States of America